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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,393	02/15/2000	Heinrich Bachmann	20347/111656	7833

7590

04/05/2002

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EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 04/05/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/504,393

Applicant(s)

BACHMANN ET AL.

Examiner

Yong Pak

Art Unit

1652

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: \_\_\_\_\_.
3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 6-36, 15, 19-36

Claim(s) withdrawn from consideration: 16-18.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

The amendment filed March 11, 2002 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment does not overcome the rejections under 35 U.S.C. 101 or 35 U.S.C. 112, 1<sup>st</sup> paragraph.

Claims 1-36 are pending.

### ***Election/Restrictions***

Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Rejections and/or objections not reiterated from previous Office action are hereby withdrawn. The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

Applicant's arguments filed on March 11, 2002 have been fully considered but they are not persuasive.

***Claim Rejections - 35 USC § 101***

Claims 6-36 remain rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Applicants argue that the claimed polynucleotides are supported by either a specific and substantial asserted utility. The examiner disagrees. As pointed out by applicants, the specification supports utility for a  $\beta,\beta$ -carotene 15,15'-dioxygenase and not for a  $\beta,\beta$ -carotene 15,15'-monooxygenase. Examples 1-6 all relate to detecting activity, cloning, purification and expression of a  $\beta,\beta$ -carotene 15,15'-dioxygenase. The specification does not support utility for a  $\beta,\beta$ -carotene 15,15'-monooxygenase. Identifying a polypeptide as a  $\beta,\beta$ -carotene 15,15'-monooxygenase does not endow the polypeptide with such a utility.

***Claim Rejections - 35 USC § 112***

Claims 6-36 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As written above, applicants argue that the claimed polynucleotides are supported by either a specific and substantial asserted utility and therefore teaches how to use the invention. The examiner disagrees. One skilled in the art clearly would not know how to use the claimed invention so that it would operate as intended without undue experimentation. As pointed out by applicants, the specification supports utility

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for a  $\beta,\beta$ -carotene 15,15'-dioxygenase and not for a  $\beta,\beta$ -carotene 15,15'-monooxygenase. Examples 1-6 all relate to detecting activity, cloning, purification and expression of a  $\beta,\beta$ -carotene 15,15'-dioxygenase. The specification does not teach how to use a  $\beta,\beta$ -carotene 15,15'-monooxygenase. Therefore, the specification does not teach how to use SEQ ID NO:1 and 3 or DNA molecules encoding SEQ ID NO:2 without undue experimentation.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak  
Patent Examiner

April 4, 2002



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